REMARKS

This responds to the Office Action mailed on May 19, 2005. No claims are amended, added or canceled. Thus, claims 1-6, 8-61, 63-78, 80-84 and 117-134 remain pending in this application.

Double Patenting Rejection

Claims 1-2, 14, 18-19, 56-57, and 63 were rejected under the judicially created doctrine of double patenting over claims 34 and 39 of U.S. Patent No. 6,784,480. Applicant respectfully traverses for at least the following reasons.

The present application was filed August 30, 2001, and U.S. Patent No. 6,784,480 ("the '480 patent") has a filing date of February 12, 2002. Thus, the '480 patent is filed after the present application. Non-statutory double patenting rejections are based on a judicially-created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. Since the present subject matter is filed before the '480 patent, Applicant respectfully submits that there would not be an unjustified or improper timewise extension of the "right to exclude" granted by the patent. Thus, the public policy reason (to avoid unjustified timewise extension) for the rejection is not been satisfied.

Additionally, Applicant respectfully submits that a two-way obviousness test should be used to determine whether a double patenting rejection is appropriate. MPEP 804(b) states:

> If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay.

The '480 patent and the present application disclose different subject matter. The '480 patent discloses and claims a gate stack with SiO_2, Ta_2O_5, a charge storing region and ZrO_2. This gate stack arrangement disclosed in the '480 patent could not have been claimed in the present, earlier filed application. Applicant further submits that, to date, Applicant's prosecution of the present application has been timely.

MPEP 804(b) further states:

> When making a two-way obviousness determination where appropriate, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Applicant respectfully submits that the claims of the present application do not anticipate the claimed gate stack in the '480 patent, which includes SiO_2, Ta_2O_5, and ZrO_2. Thus, for at least this reason, the two-way obviousness determination does not compel a conclusion of obviousness. Therefore, Applicant respectfully submits that the double patenting rejection should be withdrawn. Again, Applicant respectfully submits that "the fundamental reason to prevent unjustified timewise extension of the right to exclude" does not exist in this set of circumstances, since the '480 patent was filed after the present application was filed.

Applicant makes no assertion regarding whether one claim fully encompasses or reads on a claim in another patent. Even so, Applicant notes there is a distinction between domination and double patenting. MPEP 804 states:

> Domination and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection.

For at least the reasons provided above, Applicant respectfully requests withdrawal of the rejection, and reconsideration and allowance of the claims.

Claims 73-74, 80, and 84 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 34 and 39 of U.S. Patent No. 6,784,480. Applicant respectfully traverses. For the reasons provided above, Applicant respectfully requests withdrawal of the rejection, and reconsideration and allowance of the claims.

Claims 4, 59, and 76 were rejected under the judicially created doctrine of double patenting over claims _____ of U.S. Patent No. 6,784,480 in view of Sadd et al. (U.S. 6,444,545). Applicant respectfully traverses, noting that the rejection fails to identify the claims in '480 relied upon to make the rejection. Even so, for the reasons provided above, Applicant respectfully requests withdrawal of the rejection, and reconsideration and allowance of the claims.

Allowable Subject Matter

Claims 125-127 and 132 were allowed.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6960 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17 day of August, 2005.

KACIA LEE
Name

Kacia Lee
Signature